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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/534,414	05/11/2005	Kouhei Toyooka	074129-0521	7101
22428 7590 05/29/2008 FOLEY AND LARDNER LLP SUITE 500 3000 K STREET NW WASHINGTON, DC 20007				
EXAMINER				
JARRELL, NOBLE E				
ART UNIT		PAPER NUMBER		
1624				
MAIL DATE		DELIVERY MODE		
05/29/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/534,414

Applicant(s)

TOYOOKA ET AL.

Examiner

Noble Jarrell

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 16 is/are pending in the application.
- 4a) Of the above claim(s) 2,3,8-10 and 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,6,7,13,14 and 16 is/are rejected.
- 7) ☒ Claim(s) 4,5 and 11 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 2/25/08
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Amendment*

1. The documents that were not considered in the IDS for the non-final rejection of 11/23/2007 have each been considered.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Baik et al.(WO 98/42666, published October 1, 1998,cited in IDS and previous office action). Baik et al. teach example 31 (page 49), which anticipates claims 1 and 6 because all instances of variables R<sub>1</sub> and L are methyl, variable X is oxygen, and variable R<sub>2</sub> is 3-methoxy-4-oxy-cyclopentyl-benzene. Claim 6 is anticipated because variable R<sub>2</sub> is a substituted phenyl ring.

This rejection is maintained because the 4-oxy-cyclopentyl group is not an alkoxy group, but an cycloalkyl-oxy group.

### *Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.

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3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
6. Claims 1, 7, 13, 14, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hiraga et al. (US 4590189, issued May 20, 1986, cited in previous office action). Hiraga et al. teach species in 4, 10, 23, and 24 in table 2. These species render the elected group obvious because each instance of variable R<sub>1</sub> is H. According to *In re Lohr* (137 USPQ 548), Hydrogen vs. Methyl is not considered a patentable advance absent evidence of superior, unexpected results. In each of the specified compounds, variable R<sub>2</sub> is benzene of chlorinated benzene and variable L is the group CH<sub>2</sub>C(O)piperazine or CH<sub>2</sub>C(O)-4-methyl-piperazine. Applicant advances no evidence of superior or unexpected results. Variable X is O in each compound. Therefore the only difference between these specific compounds and the claimed compounds is the meaning of variable R<sub>1</sub>. In addition, these compounds are being used as muscle relaxants (also known as tranquilizers or sedatives) (column 9, line 30-column 10, line 13). These compounds can be administered in compositions with other ingredients in diverse formulations (tablets, capsules, injections, etc.) (column 10, lines 4-13). Capsule formulations are shown in the reference and it would require little more than routine skill in the art to prepare art recognized formulations which include injections containing these compounds. Hiraga et al. is seen to render claims 1, 7, 13, 14, and 16 obvious. This rejection is maintained in light of the submitted affidavit because even though the side effects of muscle relaxation and hypnosis are weak relative to the primary anti-anxiety effect of the drug, the compounds still exhibit the side effects of muscle relaxation and hypnosis. Muscle relaxation is one effect of anesthesia ("Anesthesia definition", <http://www.medterms.com/script/main/art.asp?articlekey=2246>, accessed May 22, 2008). Thus, the submitted affidavit does not overcome the 35 U.S.C.103 rejection of the previous office action.

**Allowable Subject Matter**

7. Claims 4, 5, and 11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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8. The following is a statement of reasons for the indication of allowable subject matter: Yoshimura et al. report the closest art (WO2005113501, published December 1, 2005, cited in previous office action). In this reference, compounds of paragraph 0012 directly read on the formulae depicted in claims 4, 5, and 11, but fail to antedate the priority date because the reference has no 102(e) date. Hence, claims 4, 5, and 11 contain subject matter for which there is not seen prior art upon which to base a rejection.

#### **Conclusion**

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Noble Jarrell whose telephone number is (571) 272-9077. The examiner can normally be reached on M-F 7:30 A.M - 6:00 P.M. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. James O. Wilson can be reached on (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Noble Jarrell/  
Examiner, Art Unit 1624

**/James O. Wilson/  
Supervisory Patent Examiner, Art Unit 1624**